UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,123	10/22/2003	Stephen J. Brand	24492-011	5348

30623 7590 08/29/2007

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY
AND POPEO, P.C.
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER	
CORDERO GARCIA, MARCELA M	
ART UNIT	**PAPER NUMBER**
1654	
MAIL DATE	**DELIVERY MODE**
08/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/691,123	BRAND ET AL.	
	Examiner	Art Unit	
	Marcela M. Cordero Garcia	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,8-10,12,13,33-45,105-107,111 and 112* is/are pending in the application.

4a) Of the above claim(s) *36-38* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,8-10,12,13,33-35,39-45,105-107,111 and 112* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *03/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to the reply received on April 15, 2005.

Claims 1, 8-10, 12-13, 33-45, 105-107 and 111-112 are pending in the application. Claims 111-112 were added.

Any rejection from the previous office action, which is not restated here, is withdrawn.

Applicant elected group I and the species: "a method of treating diabetes comprising gastrin, GLP-1 and rapamycin" in the reply filed on June 21, 2006 is acknowledged.

Claims 1, 8-10, 12-13, 33-35, 39-45, 105-107 and 111-112 are presented for examination on the merits as they read upon the instantly elected invention and species. Claims 36-38 are withdrawn as not drawn to the elected invention and species.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Please note that claim 1 has now been amended to comprise *"a gastrin and glucagon-like peptide 1"*.

Claims 1, 8-10, 12-13, 33-45, 105-107 and 111-112 are rejected under

U.S.C. 112, first paragraph, because the specification, while being enabling for the species gastrin and GLP-1, does not reasonably provide enablement for the plethora of compounds encompassed by all possible compounds with gastrin activity and for all GLP-1 active compounds as set forth below. With regards to the the term "gastrin", the term encompasses, according to the instant disclosure, any compound that binds to, interacts or stimulates the gastrin receptor. Examples include various forms of gastrin such as gastrin 34 (big gastrin, 34 amino acids), gastrin 17 (little gastrin, 17 amino acids) and gastrin 8 (mini gastrin) and other gastrin ligands. The disclosure does teach that, in general gastrin ligands share a carboxy terminal amino acid sequence Trp-Met-Asp-Phe-amide. Also contemplated are active analogs, fragments and other modifications of the above, including both peptide and non-peptide agonists or partial agonists of the gastrin such as A71378. Also included are active analogs, fragments and other modifications which for example share amino acid sequence with an endogenous mammalian gastrin, for example, share 60% sequence identity, or 70% identity or 80% identity (e.g., page 19, lines 28-31 and page 20, lines 1-18), however, no guidance/examples are provided with respect to preferred substitutions, modifications and/or fragmentations within, e.g., the 34 amino acid long big gastrin and/or non-peptidic embodiments. By the same token, the term "a glucagon-like peptide 1" reads upon any compound that binds to, interacts with or stimulates the GLP-1 receptor (e.g., page 22, lines 25-28). The term "a glucagon-like peptide-1" encompasses the residues, (1-36), (1-37), (7-36) and (7-37) of GLP-1 and also an analog with 53% homology with GLP-1 (7-36)amide known as exendin (e.g., page 23,

lines 29-31) and synthetic forms thereof (e.g., page 24, lines 1- 8). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

With regards to the effect of amino acid substitution in a peptide or protein, the art is unpredictable.

Rudinger (J. Rudinger. In: Peptide Hormones, JA Parsons, Ed. (1976) 1-7) teaches that, "The significance of particular amino acids and sequences for different aspects of biological activity cannot be predicted a priori but must be determined from case to case by painstaking experimental study." (Page 6).

SIGMA (SIGMA. Designing Custom Peptides. http://www.sigma-genosys.com/peptide_design.asp (Accessed 12/16/2004), 2 pages) states that with regards to design of peptide sequences that, "Even for relatively short sequences, there are essential and non-essential (or less important) amino acid residues, although the relative importance of the individual amino acid residues is not always easy to determine." (Page 1). SIGMA further describes what effect some substitutions may have, rather than what effect they will have on hydrophobicity, secondary structure (which will affect tertiary and quaternary structure), and solubility.

With regards to prediction of the native conformation of a protein (structure), the art is unpredictable.

Berendsen (H..J.C. Berendsen. A Glimpse of the Holy Grail? Science (1998) 282, pages 642-643) states, "The prediction of the native conformation of a protein of

known amino acid sequence is one of the great open questions in molecular biology and one of the most demanding challenges in the new field of bioinformatics." (Page 642). Berendsen states that, "Folding to the stable native state [computationally] has not (yet) occurred, and the simulations do not contain any relevant statistics on the process. The real protein will fold and refold hundreds to thousands of times until it stumbles into the stable conformation with the lowest free energy. Because this hasn't happened (and couldn't happen) in the simulations, we still cannot be sure of the full adequacy of the force field. (Page 642).

Further, the effects of a single amino acid substitution can have substantial effects on proteins in structure and/or function and are exemplified by the difference between hemoglobin (Hb) and abnormal hemoglobins, such as sickle-cell hemoglobin (HbS). VOET (D. Voet and J.G. Voet. Biochemistry, 2nd Edition.(1995), pages 235-241) teaches that the mutant hemoglobin HbE [Glu B8(26)β → Lys] has, "no clinical manifestations in either heterozygotes or homozygotes." (Page 235). Further, Hb Boston and Hb Milwaukee both have single point mutations which result in altered binding affinity and ineffective transfer from the Fe(III) to Fe(II) oxidation state. Conversely, a single point mutation in Hb Yakima results in increased oxygen binding by the heme core, and in Hb Kansas, the mutation causes the heme center to remain in the T state upon binding oxygen (rather than structurally rearranging to the R state). (Page 236).

HbS is a single point mutation, Val → Glu A3(6)β (Page 236), which results in deformation and rigidity of the red blood cell. The mutation also provides protection against most malarial strains.

Further, Smilek (D.E. Smilek, et al. Proc. Natl. Acad. Sci. USA (1991) 88, pages 9633-9637) teaches that a single amino acid substitution in the myelin basic protein peptide, "confers the capacity to prevent rather than induce EAE even after peptide-specific encephalitogenic T-cells have been activated." (Abstract).

Messer (W.S. Messer, "Vasopressin and Oxytocin", web document updated 4/3/2000; http://www.neurosci.pharm.utoledo.edu/MBC3320/vasopressin.htm; 5 pages) that two compounds, vasopressin [cyclo(1-6)CYIQNCPLG-NH_2] and oxytocin [cyclo(1-6)CYFQNCPRG-NH_2] differ by only two amino acids, as indicated, yet they have different functions. Vasopressin (antidiuretic hormone, ADH), "at low doses controls the resorption of water by the distal tubules of the kidneys and regulates the osmotic content of blood... [and at] high doses, ADH causes contraction of arteriles (sic) and capillaries, especially those of the coronary vessels, to produce localized increases in blood pressure." (page 1).

Oxytocin, on the other hand, stimulates smooth muscle contraction in the uterus, mammary glands, and the "alveoli and larger sinuses of the mammary glands to make readily available milk" (page 1).

Further, ADH has 2 types of receptors (V1 and V2) found in vascular smooth muscle and the kidney, while oxytocin has one type of receptor found in uterine and mammary smooth muscle.

Given that one could not determine the structure of a protein computationally, and that the effect of amino acid substitution is highly unpredictable, and can produce an effect opposite or different to that which is desired, it flows logically that one would be unduly burdened with experimentation to determine the effect of amino acid substitution(s), derivatization(s), deletion(s) in the plethora of receptor ligands instantly claimed, with regards to structure, function, or physical/chemical properties. Additionally, obtaining and testing the full scope of the non-peptidic agonists for GLP-1 and gastrin as defined in the specification would also require undue experimentation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 8, 10, 12-13, 107 and 111-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parikh et al. (US 6,558,952) in view of Hoffman (US 6,358,924).

Parikh et al. teaches a method of treating diabetes by administering to the individual in need thereof a composition including a gastrin (e.g., abstract, column 6, lines 10-18, 26-34 and 45-56, column 8, lines 30-53).

Parikh et al. do not teach a method of treating diabetes administering a GLP-1.

Hoffman teaches a method of treating diabetes by administering to the individual in need thereof a composition including GLP-1 (column 1, lines 20-37, column 2, lines 19-22, claims 1 and 11).

Please note that a composition encompassing both gastrin and GLP-1 would be expected to have at least additive effect with respect to reducing blood glucose and therefore reads upon the limitation of claim 9 "wherein the amount of the GLP-1 in the composition is substantially less than a minimum effective dose of the GLP-1 required to reduce blood glucose in the diabetic mammal in the absence of the gastrin" and the limitation of claim 111: "wherein the effect of administering gastrin and GLP-1 is greater than observed when gastrin and GLP-1 are administered separately". The limitation of claim 10 – further comprising measuring blood glucose or pancreatic insulin content-- is taught, e.g., at Example 4, column 17, lines 20-67 of Parikh et al. The limitation of claim 12: --further comprising measuring amount of insulin secreting cells, glucose responsiveness of insulin secreting cells, amount of proliferation of islet precursor cells and amount of mature insulin secreting cells' is taught, e.g., at Example 4, column 18, lines 10-20 of Parikh et al. Please note that the limitation of claim 13 "inducing pancreatic islet neogenesis" necessarily reads upon administration of gastrin and GLP-1. The limitation of claim 107: "wherein the diabetic subject has type I diabetes or type

II diabetes" is taught, e.g., at column 5, lines 52-58 of Parikh et al., at column 1, lines 20-25 of Hoffman and at page 2, lines 3-5 of Baeder et al. The limitation of claim 112: -- reduces fasting blood glucose levels in said mammal to a normal range-- is taught, e.g., in column 5, lines 52-58 and Example 6 of Parikh et al.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant compounds (i.e., a gastrin and a GLP-1) for their known benefit since each is well known in the art for the treatment of diabetes. Applicants invention is predicated on an unexpected result, which typically involves synergism, an unpredictable phenomenon, highly dependent upon specific proportions and/or amounts of particular ingredients. Any mixture of the components embraced by the claims which does not exhibit an unexpected result (e.g., synergism) is therefore ipso facto unpatentable. Accordingly, the instant claims, in the range of proportions where no unexpected results are observed, would have been obvious to one of ordinary skill having the above cited references before him.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. The adjustment of particular conventional working conditions [e.g., determining appropriate administration methods and/or dosages (e.g., Parikh et al., e.g., column 8, lines 30-53, columns 9-11) within such therapeutic method] is deemed merely a matter of judicious selection and routine optimization that is well within the purview of the skilled artisan. Thus the invention as a whole was clearly prima facie obvious to one of ordinary skill in the art at the time the invention was made.

Applicant's arguments

Applicant argues that it is well recognized under U.S. Law, that any rejection of a claim for obviousness over a combination of prior art references must establish that: (1) the combination produces the claimed invention; and (2) the prior art contains a suggestion or motivation to combine the prior art references in such a way as to achieve the claimed invention [In re Vaeck, 20 U.S.P.Q. 2d 1438 (Fed Cir 1991)]. The motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention [In re Napier, 34 U.S.P.Q. 2d 1782, 1784 (Fed. Cir. 1995)]. The mere fact that the prior art could be modified does not make the modification obvious unless the prior art suggests the desirability of the modification [In re Laskowski, 10 U.S.P.Q. 2d 1397, 1399 (Fed.Cir. 1989)].

Contrary to the Examiner's assertions, the combination provided unexpected results that would not have been obvious to a person skilled in the art. Parikh teaches a method of treating diabetes using gastrin/CCK receptor ligand, which encompass a number of compounds that stimulate the gastrin/CCK receptor, including gastrin 34, gastrin 17, gsatrin 8, CCK 58, CCK 33, CCK 22, CCK 12 and CCK 8 (Parikh, column 6, lines 9-18). Parikh further suggest using gastrin/CCK in combination with EGF receptor ligands which include EGF1-53, and fragments and analogs thereof (Parikh, column 6, lines 26-34). Parikh does not suggest using gastrin in combination with GLP-1, in fact, Parikh teaches away from GLP-1 to the extent it suggest gastrin/CCK in combination with EGF receptor ligands.

Hoffman does not teach or suggest administering gastrin (Hoffman, column 1, lines 20-37). Hoffman teaches using a formulation of GLP-1 and a surfactant, it does not teach using GLP-1 in combination with another receptor ligand such as gastring. Parikh does not suggest using gastrin and GLP-1 to treat diabetes. Additionally, Hoffman does not teach using GLP-1 and gastrin but rather teaches a formulation of GLP-1 containing surfactants. There is no motivation to combine the Parikh and Hoffman.

The Examiner asserts that Parikh teaches a method of treating diabetes by administering to the individual in need thereof a composition including gastrin, but does not teach administering GLP-1 and Hoffman teaches a method of treating diabetes by administering a composition including GLP-1. The Examiner further states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the gastrin and GLP-1 for their known benefit since each is well known in the art for the treatment of diabetes.

Although the Examiner stated that no unexpected results were observed, Example 1 of the specification shows that treatment with GLP-1 and gastrin was more effective at reducing fasting blood glucose levels than either gastrin alone or GLP-1 alone. Treatment with the combination reduced fasting blood glucose levels to a level in the normal range. This result is unexpected and due to gastrin and GLP-1 working in combination to treat diabetes rather than singularly or with another compound as in Parikh or Hoffman.

Response to arguments

Applicant's arguments filed March 12, 2007 and summarized above have been fully considered. Example 1, while persuasive with respect to gastrin-I 17 Leu-15 at 100 ug/kg/day and GLP-1 at 3 ug/kg/day, is not persuasive with respect to the full scope of the instant claim 1, i.e., any gastrin and any GLP-1 at any set of concentrations as set forth above in the enablement rejection for the reasons set forth above. Since the claims are drawn to a much broader invention encompassing many species as set forth in the rejection above, the evidence provided is not commensurate in scope with the invention claimed (MPEP 2144.07).

Claims 1, 33-35, 39-45 and 105-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parikh et al. (US 6,558,952) in view of Hoffman (US 6,358,924) and in view of Baeder et al. (EP 0 507 555 A1).

Parikh et al. and Hoffman are relied upon as above.

Baeder et al. teach a method for treating diabetes by administrating rapamycin (e.g., abstract and claims).

The limitation of claim 34 "the agent for suppressing immune response is a drug" is taught, e.g., at page 2, lines 50-55 of Baeder et al. The limitation of claim 39: "at least one of the composition and the agent for suppressing immune response are administered systemically" is taught, e.g. at Parikh et al., abstract, line 8 and column 8, lines 30-39; Baeder et al., page 8, lines 36-38. The limitation of claim 41: "administered as a bolus" is taught, e.g., at Parikh et al., column 8, lines 30-39; column 9, lines 8-35.

The limitation of claim 42 "at least one of the composition and the agent for suppressing immune response is administered by a route selected from the group consisting of intravenous, subcutaneous, intraperitoneal and intramuscular" is taught, e.g., at page 2, line 58 and page 3, line 1 of Baeder et al. and at column 9, lines 8-35 of Parikh et al. The limitation of claim 43 – wherein the agent for suppressing immune response is administered orally—is taught, e.g., at page 2, line 58 of Baeder et al. The limitation of claim 45 –wherein the subject is a human-- is taught, e.g., at column 5, lines 52-67 and column 6, lines 45-55 of Parikh et al.; Hoffman, e.g, abstract, lines 1-7 and Baeder et al., page 7, lines 48-54. The limitation of claims 105-106: --administering one of the gastrin or agents using a sustained release device-- is taught, e.g., at column 8, lines 54-67 and column 9, lines 1-7 of Parikh et al.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant compounds (i.e., gastrin, GLP-1 and rapamycin) for their known benefit since each is well known in the art for the treatment of diabetes. This rejection is based on the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients, In re Sussman, 1943 C.D. 518. Applicants invention is predicated on an unexpected result, which typically involves synergism, an unpredictable phenomenon, highly dependent upon specific proportions and/or amounts of particular ingredients. Any mixture of the components embraced by the claims which does not exhibit an unexpected result (e.g., synergism) is therefore ipso facto unpatentable.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. The adjustment of particular conventional working conditions [e.g., determining the mode of administration, e.g., sequential administration, within such therapeutic method, e.g., Parikh et al. column 8, lines 30-53; Baeder, e.g., claims)] is deemed merely a matter of judicious selection and routine optimization that is well within the purview of the skilled artisan.

Thus the invention as a whole was clearly prima facie obvious to one of ordinary skill in the art at the time the invention was made.

Applicant's arguments

Applicant argues that, as stated above, prior art needs to suggest or motivate a combination of references in order to make an invention obvious. Baeder teaches a method of treating diabetes using rapamycin, however, the reference does not teach or suggest using rapamycin in combination with gastrin and/or GLP-1. Instead, Baeder teaches using rapamycin in combination with insulin to treat diabetes. As such, there is no motivation to combine Parikh and Hoffman and Baeder, and as such the rejection should be withdrawn.

Response to arguments

Applicant's arguments have been fully considered but they are not persuasive for the reasons set forth above and because the motivation to combine the prior art is, as set forth above, the fact that all three compositions are used to treat diabetes.

It has been held that under KSR that "obvious to try" may be an appropriate test under 103 The Supreme Court stated in KSR:

> When there is motivation "to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, ___, 82 USPQ2d 1385, 1397 (2007).

The "problem" facing those in the art was the treatment of diabetes, and there were a limited number of methodologies available to do so. The skilled artisan would have had reason to try these methodologies with the reasonable expectation that at least one would be successful. In the instant case the three compounds: gastrin, GLP-1 and rapamycin were taught by the prior art as useful for treating diabetes as set forth above. Thus, treating diabetes is a "the product not of innovation but of ordinary skill and common sense," leading to the conclusion that invention is not patentable as it would have been obvious. Please note that the unexpected results provided are not commensurate in scope with the instant claims, as indicated above.

In addition, KSR forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness.

See the recent Board decision Ex parte Smith, --USPQ2d--, slip op. at 20, (Bd. Patt. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2s at 1396) (available at http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 8-10, 12-13, 33-35, 39-45, 105-107 and 111-112 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 13, 21, 24-26, 32-35, 44 and 101 of copending Application No. 10/532,295. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both drawn to a method of treating diabetes administering a gastrin/CCK receptor ligand and a FACGINT such as

GLP-1. Further, the instantly claimed method encompasses and/or is encompassed by the claimed method of Application '295.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments

Applicants will address any double-patenting issues with respect to the claims pending in the present application and the claims of '295 application upon the indication of allowable subject matter in the '295 application.

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcela M. Cordero Garcia whose telephone number is (571) 272-2939. The examiner can normally be reached on M-Th 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia J. Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcela M Cordero Garcia, Ph.D.
Patent Examiner
Art Unit 1654

MMCG 08/07

Cecilia J. Tsang
Supervisory Patent Examiner
Technology Center 1600